

REMARKS/ARGUMENTS

In the Office Action mailed March 21, 2006, it is stated that the support required under 37 CFR 1.173(c) for claim changes made in the amendment filed December 29, 2005 was not submitted. The Office Action requires that a supplemental response be filed to correct the issue. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks. The following supplemental remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

Claims 1, 2, 5 and 8 are presently amended. No claims are cancelled. No claims are added. As such, claims 1-8 remain pending.

Applicants thank the Examiner for the teleconference on March 24, 2006 with Applicants' undersigned representative, according to which it was agreed that a supplemental response is to be filed which includes, as recited in 37 CFR 1.173(c), "an explanation of the support in the disclosure of the patent for the changes made to the claims." The following remarks set forth the support in the disclosure for each claim amendment.

Claim 1

Claim 1 includes two separate affirmative claim amendments, both of which were made in response to the Examiner's suggestions in the Office Action dated October 4, 2005 to make the claim definite under 35 USC 112, second paragraph. The current amendment language includes: (i) "a bottom shaft piece having a [tip] shaft portion", and (ii) "wherein said top shaft cutting piece, when so opened, remains attached by attachment means to the [body] remainder of the rongeur." As to the first amendment, the shaft portion 202 of the bottom shaft piece is

clearly shown in FIG. 2 of the subject patent. The bottom shaft piece includes “the handle portion 218 of bottom shaft 202.” (Specification, col. 4, line 11). As to the second amendment, the word “body” has been removed for lack of antecedent basis for the claim term. It has been replaced with the word “remainder”, such that Claim 1 now recites the “top shaft cutting piece, when...opened, remains attached by attachment means to the remainder of the rongeur.”

Support for this amendment can be clearly seen from FIG. 3 of the subject patent, which shows the “top shaft 201 flipping up and back into the fully open position as shown (241), held to the rear of the bottom shaft 202 by elongated link 223.” (Specification, col. 3, lines 28-31). By being held to the rear of bottom shaft 202 by link 223, the top shaft piece necessarily remains attached to the remainder of the rongeur device, as claimed.

Claim 2

Claim 1 includes an affirmative claim amendment adding the phrase “cutting piece” to “top shaft”, made in response to the Examiner’s suggestions in the Office Action dated October 4, 2005 to make the claim definite under 35 USC 112, second paragraph, by providing antecedent basis for the term “top shaft cutting piece.” As shown in FIG. 2, the claimed ‘top shaft cutting piece’ is “top shaft 201” or “upper shaft 201.” (Specification, col. 3 line 65 to col. 4 line 46). Top shaft 201 is a ‘cutting piece’ because it forms part of the claimed ‘rongeur’, wherein, as is known to one skilled in the art, “rongeurs are used to excise tissue.” (Specification col. 1, line 9). An example of a prior art rongeur is discussed with reference to FIG. 1A, wherein the “gap 110 in the front of top shaft 101” is the “bite opening” for the prior art rongeur, and the “front 111 of top shaft 101” is one of the “cutting surfaces.” (Specification, col 1, lines 36-40). Accordingly, the operation of top shaft 101 as a top shaft cutting piece is well described in the

specification. The present invention depicted in FIG. 2 includes a similar “top shaft cutting piece” which is top shaft 201, the analog of top shaft 101 in the prior art rongeur of FIG. 1A. Applicants assert that the basis for the “cutting piece” nature for top shaft 201 can be clearly understood by one of ordinary skill in the art, given the clear parallels between the two top shaft elements 101 and 201.

Claims 3, 4, 6, and 7

Claims 3, 4, 6, and 7 only contain the minor amendment changing “A rongeur” to “The rongeur”, to conform their language as proper dependent claims referring to their respective antecedent base claim.

Claim 5

Claim 5 recites the following:

[A] The rongeur as in claim 1, wherein said attachment means comprises a metal link pivotally attached at one end thereof to the rear portion of said top shaft cutting piece [“and a central point on the top side” to] and at the other end thereof to a central point between the shaft and handle portions of said bottom shaft piece.

Support for Claim 5 can be clearly seen from FIG. 2 in combination with FIG. 4A, which show the recited ‘metal link’ element “link 223.” Said link is coupled to “top shaft 201”, which is “held to the rear of bottom shaft 202 by elongated link 223.” (Specification, col. 4, lines 28-31). This arrangement can be clearly derived from the elements depicted in FIGS. 2 and 4A,

namely, the shaft portion 202 of the bottom shaft piece and handle portion 218, between which the link 223 is attached at some central point, as recited in amended Claim 5.

Claim 8

Claim 8 recites the following:

A convertible rongeur comprising

a front handle piece;

a bottom shaft piece moveably attached to said front handle piece, said bottom

shaft piece having a shaft portion and a handle portion and a longitudinal

axis along said shaft portion, said front handle piece being compressed

toward said handle portion of said bottom shaft piece to operate said

rongeur; and

a top shaft cutting piece slideably engaged along said longitudinal axis, with said

shaft portion of said bottom shaft piece, wherein said top shaft cutting piece

is disengageable from said bottom shaft piece such that the top shaft

cutting piece no longer touches said bottom shaft piece but remains linked

to the remainder of said rongeur.

The recited 'front handle piece' 206 is clearly shown in FIG. 2. The recited 'bottom shaft piece moveably attached to said front handle piece, said bottom shaft piece having a shaft portion and a handle portion and a longitudinal axis along said shaft portion' is bottom shaft 202 (discussed above with respect to Claim 1), having a shaft portion 202 and handle portion 218. (Specification, col. 4, lines 10-11). The moveable attachment of the bottom shaft 202 which front handle piece 206 can be directly deduced from reference to FIGS 4A and 4B, and

recognition of the similar attachment of front handle piece 106 (the analog front handle piece 206) of prior art rongeur shown in FIG. 1A, which pivots about bottom shaft 102 (the analog of bottom shaft piece 202). (Specification, col. 1, lines 23-25). The longitudinal axis of bottom shaft 202 can be clearly deduced from the long, elongate nature and shape of the element.

The recited 'front handle piece being compressed toward said handle portion of said bottom shaft piece to operate said rongeur' with the "top shaft cutting piece slideably engaged along said longitudinal axis, with said shaft portion of said bottom shaft piece' can also be derived by reference to FIGS. 4A and 4B, which show the front handle piece 206 being compressed towards handle portion 218 to operate the rongeur device, such that the top shaft cutting piece 201 slidingly moves in relation to bottom shaft 202. This arrangement is a direct analog of the sliding arrangement of similar pieces shown in the prior art rongeur of FIG. 1A, where "top shaft 101 is slidably positioned over bottom shaft 102 by means of alignment guides 112, 114 attached to top shaft 101 which fit into channels 113, 115 in bottom shaft 102." (Specification, col. 1, lines 25-28). In the rongeur of FIG. 2, the corresponding alignment guides 212, 214 are instead in the bottom shaft 202 (rather than the top shaft 101 of the rongeur in FIG. 1A), and fit into corresponding channels 213, 215 on top shaft 201.

The recited feature of 'wherein said top shaft cutting piece is disengageable from said bottom shaft piece such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to the remainder of said rongeur' was also discussed above with respect to amended Claim 1. Support for said feature is clearly shown in FIGS. 3 and 4D. As discussed in the specification of the present patent, the top shaft 201 can be pulled back so that "alignment guides 212, 214 [on bottom shaft 202] disengage from channels 213, 215 in the top shaft 201", which "results in top shaft 201 flipping up and back in the fully open position as shown (241) [in

FIGS. 3 and 4D such that the top shaft 201 no longer touches said bottom shaft 202], held to the rear of bottom shaft 202 by elongated link 223.” (Specification, col. 4, lines 25-31). Thus, as recited in Claim 8, the top shaft piece remains linked to the remainder of said rongeur via link 223 attached to the bottom shaft piece, from which extends the rest of the rongeur device.

Based on the above remarks, it is believed that a person of ordinary skill in the art can clearly understand and interpret each claim, as amended, based on the corresponding disclosure for the claim term supported by the specification and drawings. Accordingly, Applicants believe that all claim amendments have ample support in the specification and drawings of the patent, as required by 37 CFR 1.173(c).

CONCLUSION

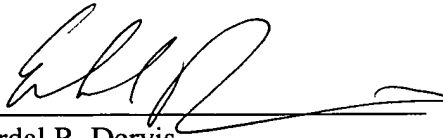
In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Docket No. 59474.21501
Application No. 09/627,018
Customer No. 30734

Patent

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21501.

Respectfully submitted,
BAKER & HOSTETLER LLP


Erdal R. Dervis
Reg. No. 51,612

Date: April 5, 2006
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1744
Facsimile: 202-861-1783